



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,669	10/23/2003	Matthew Lerner	MS305992.01/MSFTP2336US	5871
27195 7590 09/29/2008 AMIN, TUROCY & CALVIN, LLP 24TH FLOOR, NATIONAL CITY CENTER 1900 EAST NINTH STREET CLEVELAND, OH 44114				
EXAMINER RUTLEDGE, AMELIA L.				
ART UNIT 2176		PAPER NUMBER		
NOTIFICATION DATE 09/29/2008		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

doCKET1@thepatentattorneys.com
hholmes@thepatentattorneys.com
lpasterchek@thepatentattorneys.com

Office Action Summary

Application No.

10/690,669

Applicant(s)

LERNER ET AL.

Examiner

AMELIA RUTLEDGE

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 8, 11-13, 21, 24, 26 and 45-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 8, 11-13, 21, 24, 26, and 45-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: Amendment, filed 08/04/2008.
2. Claims 1, 8, 11-13, 21, 24, 26, and 45-54 are pending. Claims 1, 13, and 51 are independent claims.

Claim Objections

Claim 51 is objected to because of the following informalities:

Line 6 of claim 51 recites "...includes a set of ink stroke that corresponds to the retained electronic ink information."

Appropriate correction is required.

Priority

The application is a continuation-in-part of application 10/291,214, filed 11/10/2002. The disclosure of the prior-filed application fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application (1, 8, 11-13, 21, 24, 26, 45-54), in particular the disclosure of the prior-filed application fails to provide adequate support for "a file preview operation", since no mention of a file preview is disclosed; and for all of the combined limitations of new claims 51-54.

When applicant files a continuation-in-part whose claims are not supported by the parent application, the effective filing date is the filing date of the child CIP (10/23/2003). Any prior art disclosing the invention or an obvious variant thereof having

Art Unit: 2176

a critical reference date more than 1 year prior to the filing date of the child will bar the issuance of a patent under 35 U.S.C. 102(b). Paperless Accounting v. Bay Area Rapid Transit System, 804 F.2d 659, 665, 231 USPQ 649, 653 (Fed. Cir. 1986).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 51-54 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding independent claim 51, claim 51 recites the following limitations (bold text added) which have not been described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention:

storing a file;

obtaining electronic ink information that relates to the file; retaining the obtained electronic ink information in an ink serialized format;

defining a metadata property associated with the stored file, the metadata property

*includes a set of ink stroke that corresponds to the retained electronic ink information; collecting a rendering command and bitmap dimensions;
converting the electronic ink information from the ink serialized format to a bitmap of the collected bitmap dimensions;
preparing a file listing;
querying files to be included in the file listing to discover ink files; and
populating the file listing with at least a portion of ink files discovered in the query.*

It appears that the limitations (in bold) of newly claimed independent claim 51 are supported by p. 25, par. 73 of applicants' specification. While paragraph 73 of the specification discloses querying files for "electronic ink titles", the specification does not disclose "ink files". A text search of the specification for "ink files" did not disclose any mention of "ink files" anywhere in the specification.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1, 8, 11-13, 21, 24, 26, and 45-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moran, U.S. Patent No. 6,509,912, issued January 2003, in view of Saund, U.S. Patent No. 6,411,732 B1, issued June 2002, and**

further in view of Matthews, et al. ("Matthews"), U.S. Patent No. 6,028,604, issued February 2000.

4. **Regarding independent claim 1**, Moran teaches domain objects, programmatically equivalent to the claimed property values, which are context specific representations of information that are used in a freeform graphics system (Abstract, Figs. 22 and 26, col. 2, l. 28-57; col. 13, l. 13-col. 14, l. 23; claim 1), and that domain objects are represented in the system by a graphic object, i.e., icon, representing an instance of the domain object.

Moran teaches a storage, access, and rendering system for the domain objects (col. 6, l. 20-col. 7, l. 25), compare to claim 1, *a storage system that stores the property value of the document or file in electronic ink format; and an ink access system that allows the operating system to access the stored property value in electronic ink format, wherein the rendering system renders the stored property value in electronic ink format as part of a file preview operation.*

Moran teaches that the property value in electronic ink format includes an electronic ink title for the document or file (col. 13, l. 13-col. 14, l. 23; especially col. 14, l. 5-6; col. 21, l. 52-60), and that the title may be rendered as part of a file list operation (col. 10, l. 60-col. 11, l. 31). Moran teaches that the title may be rendered as part of a file preview operation (col. 13, l. 20-29), since Moran discloses that the user may expand the information about a domain object by double tapping on the icon, this will result in another layout of the domain object being displayed as an overlay, i.e., file preview. Moran teaches assigning a title to the document, equivalent to a document

filename, rendered in electronic ink (col. 13, l. 13-col. 14, l. 23; especially col. 14, l. 5-6; col. 21, l. 52-60), compare to *wherein the property value in electronic ink format includes an electronic ink filename for the document or file.*

While Moran teaches a file preview operation, Moran does not explicitly teach that *the file preview discloses a limited information portion of the document or file.* However, Matthews teaches a preview data structure to provide for a variety of multimedia presentations, which includes file types and icons to display information and text associated with an application, and which may display a limited information portion of the file (col. 15, l. 37-col. 16, l. 39). Matthews teaches retrieving and playing the preview files, and if the selection was chosen by the user for execution, the selected application, i.e., file, will be retrieved (col. 16, l. 1-18).

Moran teaches that the system receives a property value of a document or file on the system in electronic ink format (col. 21, l. 25-51; col. 22, l. 8-23). Moran teaches that the property value is received as part of a file or document save operation because Moran teaches that system operations can be associated with user actions and the class definition of a domain object (col. 9, l. 50-col. 10, l. 10), therefore Moran suggests that the domain objects, i.e., property values may be received as part of a file or document save operation. While Moran does not explicitly teach *a rendering system for rendering a file save interface in response to the input system receiving the file save command, the input system configured to receive in electronic ink format a property value of a document or file on or accessible by the computer system in the file save interface*; Saund teaches an electronic ink interface board for rendering a file save

interface, the input system configured to receive in electronic ink format a property value of a document or file on or accessible by the computer system in the file save interface, because Saund teaches that the electronic ink board allows a user to draw interface elements representing save actions (Fig. 31, 33) and performing file save commands for electronic ink property values in the save interface (col. 6, l. 45-col. 7, l. 64). For example, Saund teaches rendering an electronic ink file save interface and saving an image file or text (col. 7, l. 5-38).

Moran, Matthews, and Saund are directed toward graphical user interface systems. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the user drawn electronic ink interface elements and tokens disclosed by Saund with the freeform graphics system and domain objects disclosed by Moran, and the file preview features disclosed by Matthews, since Moran, Saund, and Matthews each disclosed known prior art graphical user interface elements that could have been combined to produce predictable results; because Matthews disclosed the use of a variety of file types for file previews (col. 15, l. 37-63), and Moran and Saund disclosed the storage of ink objects and properties in systems which would have facilitated the combination of the disclosed graphical user interface elements.

Regarding dependent claim 8, Moran teaches that the input system is activated in response to a command from an application program requesting activation of electronic ink input with respect to at least one document or file in the application program, since Moran teaches that the freeform editing program requests activation of

electronic ink input with respect to documents or files in the program (col. 6, l. 20-col. 7, l. 25).

Regarding dependent claims 11 and 12, Moran teaches that the input system receives from a user a change to the property value in electronic ink format associated with the document or file (col. 13, l. 13-col. 14, l. 23; claim 1), and that the property value in electronic ink format includes an electronic ink title (col. 13, l. 13-col. 14, l. 23; especially col. 14, l. 5-6; col. 21, l. 52-60).

Regarding independent claim 13, Moran teaches domain objects, programmatically equivalent to the claimed property values, which are context specific representations of information that are used in a freeform graphics system (Abstract, Figs. 22 and 26, col. 2, l. 28-57; col. 13, l. 13-col. 14, l. 23; claim 1), and that domain objects are represented in the system by a graphic object, i.e., icon, representing an instance of the domain object.

Moran teaches a storage, access, and rendering system for the domain objects (col. 6, l. 20-col. 7, l. 25), compare to claim 1, *receiving a file save command; ...storing the property value of the document or file in electronic ink format for a later display on a display-interface in electronic ink format; providing operating system access to the stored property value in electronic ink format; and rendering the stored property value in electronic ink format as part of a file preview operation.* Moran teaches that the property value in electronic ink format includes an electronic ink title for the document or file (col. 13, l. 13-col. 14, l. 23; especially col. 14, l. 5-6; col. 21, l. 52-60), and that the title may be rendered as part of a file list operation (col. 10, l. 60-col. 11, l. 31). Moran teaches

that the title may be rendered as part of a file preview operation (col. 13, l. 20-29), since Moran discloses that the user may expand the information about a domain object by double tapping on the icon, this will result in another layout of the domain object being displayed as an overlay, i.e., file preview. Moran teaches assigning a title to the document, equivalent to a document filename, rendered in electronic ink (col. 13, l. 13-col. 14, l. 23; especially col. 14, l. 5-6; col. 21, l. 52-60), compare to *wherein the property value in electronic ink format includes an electronic ink filename for the document or file*.

While Moran teaches a file preview operation, Moran does not explicitly teach that *the file preview operation filters information of the document or file such that a portion less than a whole of the document or less than a whole of the file is part of a file preview*. However, Matthews teaches a preview data structure to provide for a variety of multimedia presentations, which includes file types and icons to display information and text associated with an application, and which may display a limited information portion of the file (col. 15, l. 37-col. 16, l. 39). Matthews teaches retrieving and playing the preview files, and if the selection was chosen by the user for execution, the selected application, i.e., file, will be retrieved (col. 16, l. 1-18).

Moran teaches that the system receives a property value of a document or file on the system in electronic ink format (col. 21, l. 25-51; col. 22, l. 8-23). Moran teaches that the property value is received as part of a file or document save operation because Moran teaches that system operations can be associated with user actions and the class definition of a domain object (col. 9, l. 50-col. 10, l. 10), therefore Moran suggests

that the domain objects, i.e., property values may be received as part of a file or document save operation. While Moran does not explicitly teach *displaying a file save interface responsive to receiving the file save command; receiving in electronic ink format in the file save interface a property value of a document or file on or accessible by a computer*; Saund teaches an electronic ink interface board for rendering a file save interface, the input system configured to receive in electronic ink format a property value of a document or file on or accessible by the computer system in the file save interface, because Saund teaches that the electronic ink board allows a user to draw interface elements representing save actions (Fig. 31, 33) and performing file save commands for electronic ink property values in the save interface (col. 6, l. 45-col. 7, l. 64). For example, Saund teaches rendering an electronic ink file save interface and saving an image file or text (col. 7, l. 5-38).

Moran, Matthews, and Saund are directed toward graphical user interface systems. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the user drawn electronic ink interface elements and tokens disclosed by Saund with the freeform graphics system and domain objects disclosed by Moran, and the file preview features disclosed by Matthews, since Moran, Saund, and Matthews each disclosed known prior art graphical user interface elements that could have been combined to produce predictable results; because Matthews disclosed the use of a variety of file types for file previews (col. 15, l. 37-63), and Moran and Saund disclosed the storage of ink objects and properties in systems which would have facilitated the combination of the disclosed graphical user interface elements.

Regarding dependent claim 21, 24, and 26, claims 21, 24, and 26 reflect the methods implemented by the system as claimed in claims 8, 11, and 12, respectively, and are rejected along the same rationale.

Regarding dependent claim 45, Moran teaches disclosing the file preview (col. 13, l. 20-29), since Moran discloses that the user may expand the information about a domain object by double tapping on the icon, this will result in another layout of the domain object being displayed as an overlay, i.e., file preview.

Regarding dependent claim 46 and 47, Matthews teaches that the preview includes at least two functions, and that one of the functions includes expanding the file preview into the file, since Matthews teaches retrieving and playing the preview files, and if the selection was chosen by the user for execution, the selected application, i.e., file, will be retrieved (col. 16, l. 1-18).

Regarding dependent claims 48-50, claims 48-50 are substantially similar to dependent claims 45-47, and are rejected along the same rationale.

1. Claims 51-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dresevic, et al. ("Dresevic"), U.S. Pub. No. 2002/0013795 A1, published January 2002, in view of Lopresti, U.S. Patent No. 5,734,882, issued March 1998.

Regarding independent claim 51, Dresevic teaches *a method, comprising: storing a file; obtaining electronic ink information that relates to the file; retaining the obtained electronic ink information in an ink serialized format*; because Dresevic

teaches serially identifying a list of ink properties from an entered ink object (Fig. 3; Fig. 15, par. 0037-0041; par. 0067-0073).

Drešević teaches *defining a metadata property associated with the stored file, the metadata property includes a set of ink stroke that corresponds to the retained electronic ink information*; because Drešević teaches a data structure having an ink object identifier, as well as tags for ink properties (par. 0074-0086; Fig. 15).

Drešević teaches assigning a size to an ink space (par. 0112) as well as maintaining a drawing attributes table (par. 0013-0121), but does not explicitly *teach collecting a rendering command and bitmap dimensions; converting the electronic ink information from the ink serialized format to a bitmap of the collected bitmap dimensions*; however, Lopresti teaches a system and method for storage and retrieval of file and document names for use with pen based computing systems (col. 3, l. 30-col. 4, l. 37; Fig. 4; Fig. 5). Lopresti teaches converting from on-line handwriting processing systems to provide not only a bitmap of the created image, but also to store the x-y coordinates at each moment in time, i.e., an ink serialized format, and to create a bitmap from the "pen stroke" information (col. 4, l. 5-37).

Drešević suggests but does not explicitly teach *preparing a file listing; querying files to be included in the file listing to discover ink files; and populating the file listing with at least a portion of ink files discovered in the query*, because Drešević teaches maintaining a lookup table for ink properties (par. 0076), as well as assigning unique identifiers to ink object identifiers and tags (par. 0077-0086). Therefore Drešević teaches a table and identifiers which could be queried. While Drešević does not

explicitly teach *querying files to be included in the file listing to discover ink files*;

Lopresti teaches the use of name extensions, image information and a file listing such as size, date, and time of creation, to allow search and querying of the ink files, and populating a file listing for browsing by the user (col. 5, l. 45-col. 6, l. 13).

Both Dresevic and Lopresti are directed to the storage of electronic ink. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the serial ink storage method disclosed by Dresevic with the method for storage and retrieval of file and document names for use with pen based computing systems disclosed by Lopresti, since Dresevic was directed to standardizing methods of electronic ink storage (par. 0005-0007), and therefore it would have been obvious and desirable to apply Dresevic to Lopresti, in order to produce a standardized and portable system for assigning electronic ink titles to computer files.

Regarding dependent claim 52, Dresevic teaches *defining an enhanced parallel property associated with the stored file, the parallel property is in an enhanced metadata format*, because Dresevic teaches maintaining a lookup table for ink properties (par. 0076), as well as assigning unique identifiers to ink object identifiers and tags (par. 0077-0086).

Regarding dependent claim 53, Dresevic teaches *promoting the metadata property and enhanced parallel property into a data performance cache*, because Dresevic teaches storing only custom GUIDs (unique identifiers) in a serialized format, which represent custom ink object properties (par. 0215-0220).

Regarding dependent claim 54, while Dresevic does not explicitly teach *displaying populated ink tiles in an appropriate location in place of text information*, Lopresti teaches a system and method for storage and retrieval of file and document names for use with pen based computing systems, displaying populated ink titles for files in place of text information (col. 3, l. 30-col. 4, l. 37; Fig. 4; Fig. 5).

Both Dresevic and Lopresti are directed to the storage of electronic ink. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the serial ink storage method disclosed by Dresevic with the method for storage and retrieval of file and document names for use with pen based computing systems disclosed by Lopresti, since Dresevic was directed to standardizing methods of electronic ink storage (par. 0005-0007), and therefore it would have been obvious and desirable to apply Dresevic to Lopresti, in order to produce a standardized and portable system for assigning electronic ink titles to computer files.

Response to Arguments

2. Applicant's arguments with respect to amended claims 1 and 13 have been considered but are moot in view of the new ground(s) of rejection.
3. The new grounds of rejection includes the Matthews reference, which is being relied upon to disclose the newly claimed limitations: ...*wherein the rendering system renders the stored property value in electronic ink as part of a file preview operation, the file preview discloses a limited information portion of the document or file...* (Claim 1).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Terry et al., "Recognizing Creative Needs in User Interface Design", C&C '02: Proceedings of the 4th conference on Creativity & Cognition, published October 2002, p. 38-44.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AMELIA RUTLEDGE whose telephone number is (571)272-7508. The examiner can normally be reached on Monday - Friday 9:30 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached on 571-272-4137. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Amelia Rutledge/
Examiner, Art Unit 2176